

REMARKS

This application has been reviewed in light of the Office Action dated December 15, 2004. Claims 41-80 are presented for examination, of which Claims 41-43, 47, 51-53, 57, 61-63, 67, 71-73, and 77 are in independent form. Claims 1-40 have been canceled, without prejudice or disclaimer of subject matter. Favorable reconsideration is requested.

Applicant notes with appreciation the indication that Claims 8, 9, 18, 19, 28, 29, 38, and 39 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. Claims 8 and 9 have been so rewritten as new Claims 41 and 42, respectively. Accordingly, Claims 41 and 42 are believed to be in condition for allowance. Independent Claims 51, 61, and 71 are method, computer-readable storage medium, and computer program claims respectively corresponding to apparatus Claim 41, and are also believed to be in condition for allowance. Similarly, Claims 52, 62, and 72 are method, computer-readable storage medium, and computer program claims respectively corresponding to apparatus Claim 42, and are also believed to be in condition for allowance.

Claims 1-7, 10-17, 20-27, 30-37, and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004-0236719 A1 (*Horvitz*). Cancellation of Claims 1-7, 10-17, 20-27, 30-37, and 40 renders their rejections moot.

Applicant provides the following comments regarding the patentability of Claims 43-50, 53-60, 63-70, and 73-80 over *Horvitz*.

The aspect of the present invention set forth in Claim 43 is an E-mail printing apparatus. The apparatus includes a reception unit, adapted to receive E-mail, a setting unit, adapted to set a print limit, and a print unit, adapted to print the E-mail received by the reception unit up to the print limit set by the setting unit.

Horvitz relates to transmitting information, such as text, images, and software components, given constrained resources. *Horvitz* discusses receiving E-mails and truncating the message of an E-mail into a predetermined length. However, nothing has been found in *Horvitz* that would teach or suggest setting a print limit, and printing the E-mail received by the reception unit up to the print limit set by the setting unit, as recited in Claim 43.

Accordingly, Applicant submits that Claim 43 is clearly patentable over *Horvitz*.

Independent Claims 53, 63, and 73 are method, computer-readable storage medium, and computer program claims respectively corresponding to apparatus Claim 43, and are believed to be patentable over *Horvitz* for at least the same reasons as discussed above in connection with Claim 43.

The aspect of the present invention set forth in Claim 47 is an E-mail printing apparatus. The apparatus includes a reception unit, adapted to receive E-mail, a setting unit, adapted to set a print limit, and a discrimination unit, adapted to discriminate upon printing the E-mail received by the reception unit, whether or not the E-mail exceeds the print limit set by the setting unit. The apparatus also includes a print unit, adapted to print the E-mail received by the reception unit if the discrimination unit discriminates that the E-mail does not exceed the print limit set by the setting unit, and for not printing the E-mail if the discrimination unit discriminates that the E-mail exceeds the set print limit.

Applicant has found nothing in *Horvitz* that would teach or suggest printing the E-mail received by the reception unit if the discrimination unit discriminates that the E-mail does not exceed the print limit set by the setting unit, and not printing the E-mail if the discrimination unit discriminates that the E-mail exceeds the set print limit, as recited in Claim 47.

Accordingly, Applicant submits that Claim 47 is clearly patentable over *Horvitz*.

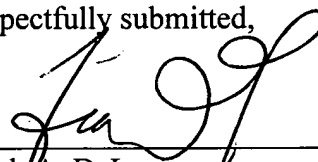
Independent Claims 57, 67, and 77 are method, computer-readable storage medium, and computer program claims respectively corresponding to apparatus Claim 47, and are believed to be patentable over *Horvitz* for at least the same reasons as discussed above in connection with Claim 47.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Frank A. DeLucia
Attorney for Applicant
Registration No. 42,476

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200